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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,504	05/04/2001	William Donovan Quigg	33582-8001US1	8692

25096 7590 08/16/2006

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EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,504

Applicant(s)

QUIGG, WILLIAM DONOVAN

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 and 49-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 and 49-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-47 and 49-65 have been examined. Application 09/849,504 has a filing date 05/04/2001 Claims Priority from Provisional Application 60/202,583 (05/09/2000).

Response to Amendment

2. In response to Non Final Rejection filed 02/28/2006, the Applicant filed an Amendment, which amended claim 26.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11, 14, 16-18, 20-23, 26, 27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, 61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263).

A computer system for processing a paper product, comprising:

a product order tracker configured to receive a paper product order from a paper purchaser (see "commercial user" column 9, lines 1-5) to purchase a paper product that is produced by a manufacturer (see column 8, lines 35-40)

a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product (see column 9, line 42 – column 10, line 25) and

a paper product tracker configured to provide instructions for creating the enclosure for the paper product (see column 6, lines 50-52), the enclosure having the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the manufacturer, the paper purchaser, and the third-party advertiser are different entities (see column 8, lines 1-40); and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product (see column 10, lines 14-20; column 13, lines 5-10). Ryan does not expressly teach that the paper product includes a roll of paper or a plurality of unbound, stacked paper sheets. However, Giacomozzi teaches a wrapper for a plurality of unbound, stacked paper sheets (*i.e.* paper handkerchiefs), where promotional messages or advertisements are printed on said wrapper and where said advertisements are not linked to the contained paper product (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional materials into the wrappers of paper products (*i.e.* paper handkerchiefs), as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (*i.e.* handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan and in view that said paper manufacturers would be

Art Unit: 3622

motivated to use said payment to lower the selling price of said manufacturers' paper products in order to better compete with other sellers of said paper products. Third party advertisers would be motivated to pay Giacomozzi's paper manufacturers to include advertisements into the Giacomozzi's paper enclosures using the targeting system taught by Ryan in view that said advertisers would be able to better target their advertisements based upon customers profiles, therefore, increasing the probability that said advertisements would reach their intended target. Commercial users (see Ryan column 9, lines 1-3) would be motivated to include advertisements into purchase paper products in view that said advertisements would permit said users to purchase said products at a lower price in comparison of purchasing said products without advertisements. Official Notice is taken that it is old and well known in the business art that retailers and/or manufacturers lower the price of their inventory for the purpose of making their inventory more attractive to buyers and therefore, increasing the probability of selling said inventory. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that manufacturers and/or retailers of paper products would be motivate to include advertisements into wrappers of said paper products in view that the money pay by advertisers for said including would allow said manufacturers and/or retailers to lower the selling price of said products, making their products more attractive to buyers and therefore, increasing the probability of selling said products.

As per claims 2, 14, 16, 18, 20-23, 26, 27, 31, 32, 34-39, 49, 52-54, 58-59 and 62-63, Ryan teaches:

The computer system of claim 1, further comprising a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material and tracking receipt of remuneration from the paper purchaser for the paper product (see Ryan column 10, lines 7-17).

As per claim 3, Ryan teaches:

The computer system of claim 1, further comprising an artwork tracker configured to provide instructions for creating a fixed medium that includes the promotional material (see Ryan column 6, lines 50-55).

As per claims 4, 30 and 51, Ryan teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to coordinate enclosing the paper product with a particular enclosure based on the content of the promotional material, the identity of the paper purchaser, and/or a location to which the paper product is to be delivered (see column 9, lines 42-55 "address restriction data").

As per claim 5, Ryan teaches:

The computer system of claim 1 wherein the promotional material order is a first promotional material order for first promotional material and the third-party advertiser is a first third-party advertiser, and wherein the promotions order tracker is configured to receive a second promotional material order from a second third-party advertiser to place second promotional material on the enclosure (see column 10, lines 54-57).

As per claim 6, Ryan teaches:

The computer system of claim 1 wherein the product order tracker is configured to receive a paper product order (see column 1, lines 47-50) but does not expressly teach for unbound, stacked sheets of paper and/or a roll of paper. However, Giacomozzi teaches a wrapper for a plurality of unbound, stacked paper sheets (*i.e.* paper handkerchiefs), where promotional messages or advertisements are printed on said wrapper and where said advertisements are not linked to the contained paper product (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional materials into the wrappers of paper products (*i.e.* paper handkerchiefs), as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (*i.e.* handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan.

As per claim 7, Ryan teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper (see column 9, lines 42-67) but does not expressly teach configured to enclose unbound stacked sheets of paper. However, Giacomozzi teaches a wrapper for a plurality of unbound, stacked paper sheets (*i.e.* paper handkerchiefs), where promotional messages or advertisements are printed on said wrapper and where said advertisements are not linked to the contained paper product (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional

materials into the wrappers of paper products (i.e. paper handkerchiefs), as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (i.e. handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan.

As per claim 17, Ryan teaches:

The method of claim 11, further comprising tracking receipt of remuneration from the paper purchaser to an intermediate party for the paper product (see column 13, lines 1-10).

As per claim 40, Ryan teaches:

The method of claim 34 wherein providing instructions for disposing promotional material includes providing instructions for printing an advertisement on an external surface of the enclosure (see column 9, lines 42-67).

As per claim 65, Ryan teaches:

The method of claim 34, further comprising instructing another entity to dispose the promotional material on the enclosure (see column 10, lines 54-60).

4. Claims 8, 9, 24, 28, 42 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Itkonen (US 5,473,863).

As per claims 8, 24, 28, 42 and 56, Ryan teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper. However, Itkonen teaches a method for wrapping

Art Unit: 3622

a roll of paper, where said wrapper is often printed with advertisement (see column 1, lines 64-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that papers' manufacturers would be motivated to enclose paper rolls with the Itkonen's roll wrapper in view that said wrapper would include promotions that would subsidize the cost of producing and wrapping said paper roll, as taught by Ryan.

As per claim 9, Ryan teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on paper enclosure (see column 9, line 42 – column 10, line 25) but does not expressly teach that said enclosure is a box configured to enclose the paper product (see column 9, line 42 – column 10, line 25). However, Giacomozzi teaches a wrapper for a plurality of unbound, stacked paper sheets (i.e. paper handkerchiefs), where promotional messages or advertisements are printed on said wrapper and where said advertisements are not linked to the contained paper product (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional materials into the wrappers of paper products (i.e. paper handkerchiefs), as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (i.e. handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan.

Art Unit: 3622

5. Claims 10, 25, 33, 41, 55, 60 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Crossman (US 5,035,515).

As per claims 10, 25, 33, 41, 55, 60 and 64, Ryan fails to teach:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for a coupon placed on or enclosed by the enclosure. However Crossman teaches package wrappers having detachable coupons (see figure 1). Therefore, It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that manufacturer of paper products would include third party advertisers coupons into a package wrappers, as taught by Crossman in order to offset the cost of producing said products by billing advertisers for said including, as taught by Ryan.

6. Claims 12, 13, 15, 19, 46, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Loeb (US 6,421,652).

As per claims 12, 13, 15, 19, 46, 47 and 50, Ryan teaches:

The method of claim 11 but fails to teach wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or a third-party advertiser and tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material. However, Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would

have been obvious to a person of ordinary skill in the art the time the application was made, to know that Ryan would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

Response to Arguments

7. Applicant's arguments, filed 05/30/2006, with respect to the rejection(s) of claim(s) 1-47 and 49-65 under Ryan and Villemure regarding that Villemure does not teach a reams with a display surface for information and advertisement have been fully considered and is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ryan and Giacomozzi.

The Applicant argues that in Ryan, third party advertisers cannot exercise any control over who receives the messages and quoted Ryan's col 2, lines 65-67. The Examiner answers that Ryan's col 2, lines 65-67 is part of Ryan's background of the invention where Ryan explains the problem with the prior arts where advertisers do not have control over who receives their messages. However, Ryan's invention resolves this problem by giving advertisers control over targeting their messages¹.

The Applicant argues with respect to the Declaration of Commercial Success that even after the Examiner manipulated the data in a manner disfavorable to the Applicant,

¹ Ryan col 11, line 60 – col 12, line 22; col 9, lines 42-67

the Examiner concedes that the claimed invention resulted in a 28% increase of sales. The Examiner answers that the Applicant is claiming a 68% increase of sales as evidence of commercial success and the data provided by the Applicant do not sustain said claim. Therefore, evidence of market share or as to what sales would normally be expected in the market would have been needed in order to make a judgment about said commercial success.

Conclusion

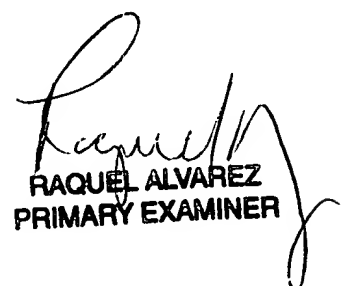
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
August 10, 2006


RAQUEL ALVAREZ
PRIMARY EXAMINER